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Appl No.: 10/623,227
Reply to Office Communication of April 25, 2007

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MAY 16 2007

Atty. Dkt. No:
UCI-273DIV

REMARKS/ARGUMENTS

Favorable consideration of this application is respectfully requested.

The present application is a divisional of parent application Serial No. 09/851,025, filed May 08, 2001, now U.S. Patent 6,653,005, which claims the benefit of priority from U.S. Provisional Application Serial No. 60/203,370, filed May 10, 2000 and included Claims 1 – 43. When the present divisional application, Serial No. 10/623,227 was filed July 18, 2003, Applicant elected to cancel Claims 1 – 36 and to prosecute Claims 37-43.

In a telephone conversation with Applicant's attorney on April 13, 2006, a restriction requirement and an election was required for one invention in Claims 37-40 or another invention in Claims 41-43; a provisional election was made with traverse to prosecute Claims 37 – 40. Claims 41-43 are now canceled by Applicant's amendment filed August 01, 2006; Claims 37-40 were pending at the time of this Final Action.

In the amendment, after the Final Action mailed on October 05, 2006, Applicant amended independent claims 37 and 39 by incorporating the substance of dependent claims 38 and 40, respectively. Support for the amendments to Claim 37 is found in the original dependent claim 38; in the specification at page 19, lines 4-22; page 20, lines 9 – 20; Example 8 and Figure 4. Support for the amendments to Claim 39 is found in the original dependent claim 40; in the specification at page 19, lines 14 – 22; page 20, lines 11-20 and Example 8. Claims 38 and 40 are canceled. No new matter was added.

A further Amendment was filed on February 5, 2007, after an Advisory Action on January 29, 2007, a telephone interview with the Examiner on February 1, 2007, wherein Applicant made further amendments to independent Claims 37 and 39 and added new claims 44 -- 61 which addressed the usefulness of the inventive product in cleaning oil spills on water.

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In the Office Communication of April 25, 2007, the Examiner stated that the amendment response of February 5, 2007 is non-responsive because the amendment effectively canceled "all claims drawn to the elected invention" and presented claims drawn to a non-elected invention focusing on "... a method of use of the carbon" fibers.

Applicant has amended independent Claims 37 and 39 to remove the "use" language, canceled claims 49-50, 52-54, and 57-61, and amended the remaining dependent claims 44-48, 51, 55, 56 to remove "use" language. Support for the amendments can be found in the specification on pages 19 and 20 and Fig. 4. There are two independent claims and eight dependent claims now pending. No new matter is added by the amendments.

Favorable reconsideration is earnestly solicited in view of the following remarks directed to the Examiner's remarks in the Advisory Action of January 29, 2007, a telephone interview with the Examiner on February 1, 2007, the Office Communication of April 25, 2007, and a telephone interview with the Examiner on May 1, 2007.

Applicant distinguishes the present invention from the prior art by providing the details of physical properties and method of production for the novel carbon fibers produced without metallic catalysts.

It was not known prior to Applicant's invention that carbon filaments or fibers, approximately 1 micron in mean diameter, with a filamentous structure that is loose, curved, elongated, worm-shaped, could be produced during the thermocatalytic decomposition of hydrocarbons in the presence of carbon black or activated charcoal catalysts. This inventive concept is now claimed in the amended independent claim 37 to the product and independent claim 39 to the method for making the product.

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Applicant has admitted in the specification at page 20, lines 13-16 that "the invention takes advantage of the . . . distinct hydrophobic nature of the carbon surface, . . ."

There is no teaching, nor suggestion for modifying the references of record to provide the novel filamentous carbon particles of the amended claims. Under well recognized rules of the MPEP (for example, section 706.02(j)), the teaching or suggestion to make the claimed compounds and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. In re Vacck, 947 F. 2nd 488, 20 USPQ 2d 1438 (Fed. Cir. 1991).

The application and claims are believed in condition for allowance in their amended form; allowance of Claims 37, 39, 44-48, 51, 55 and 56 is respectfully requested. If the Examiner believes that an interview would be helpful, the Examiner is requested to contact the attorney at the below listed number.

Respectfully submitted,



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